

REMARKS/ARGUMENTS

Reconsideration of the captioned application in view of the foregoing amendment and following remarks is respectfully requested.

A Petition to Extend the Time to respond to the pending Office Action by three months is enclosed.

The claims pending and under consideration are claims 1-25.

Claims 1, 5, 11, 20 and 23 are rejected under 35 USC §112, second paragraph as allegedly indefinite. This rejection has been obviated by amendment of claims 1, 5, 11, 20 and 23.

In the Office Action, it is asserted that "parenthetical subject matter renders the claims in which they appear indefinite". Applicants respectfully submit that the claims as originally written, with parenthetical subject matter, were clear and definite and would be readily understood by one skilled in the art. Nonetheless, to advance prosecution, Applicants have amended claims 1, 5, 11, 20 and 23 to delete the parenthesis.

Accordingly, Applicants submit that the claims meet the requirements of 35 USC §112, second paragraph. Thus Applicants respectfully request that the rejection under 35 USC §112, second paragraph be withdrawn.

Claims 1-25 are rejected under 35 USC §112, first paragraph as the subject matter allegedly "was not described in the specification in such a way as to enable one skilled in the art...to make and/or use the invention." This rejection is respectfully traversed.

Applicants submit that the specification more than adequately teaches one skilled in the art how to make (see, for example, page 14, lines 20-24) and use (see, for example, page 16, line 1 through page 18, line 2) the claimed invention.

Applicants respectfully submit that the burden is on the Patent Office to come forward with evidence to support a rejection of lack of enablement. As the CCPA stated in In re Marzocchi, 169 USPQ 367, 370 (CCPA 1971);

It is incumbent upon the Patent Office, whenever a rejection on this basis [assertion of lack of enablement] to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with

acceptable evidence or reasoning which is inconsistent with the contested statement. (emphasis added)

No acceptable evidence, as required under Marazocchi, has been presented to refute applicants' position that the specification does just that –enables one skilled in the art to practice the invention. Allegations that the specification is not enabling must be supported “by factual evidence or reasoning substantiating [the] doubt so expressed. [M]ere speculative, factually unsupported allegation[s]. . . cannot negate appellants' assertion that their invention is operative in the broad aspect as claimed.” (emphasis added) Ex parte Kronenthal, Appeal No. 562-14, board of Appeals, page 2. Indeed, “no persuasive reasons has been given [in the action] why the specification does not realistically enable, one skilled in the art to practice the invention, as broadly as it is claimed.” In re Bowen 181 USPQ 4, 51-52 (CCPA 1974).

In the Office Action, it is asserted that “each prospective embodiment, as well as future embodiments as the art progresses, would have to be empirically tested. Undue experimentation would be required to practice the invention as it is claimed in its current scope.”

However, it is well settled that the need for experimentation, if any, is not a sufficient basis for a rejection under 35 USC §112.

Attention is directed to Ex parte Jackson, 217 USPQ 804 (BPAI 1982) wherein the Board reversed a §112 rejection based on undue experimentation, and stated that

The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the invention claimed. (at 807) (emphasis added)

Based on the foregoing, Applicants submit that practicing the invention would not require undue experimentation.

Accordingly, Applicants submit that the application meets the requirements of 35 USC §112, first paragraph.

Thus, Applicants request that the rejection under 35 USC §112, first paragraph, be withdrawn.

Serial No. 10/081,713

Since all the claims are of proper form and patentable over the cited art, an allowance and notice thereof is respectfully requested.

Respectfully submitted,

By: 

Ellen Ciambone Coletti
Reg. No. 34,140

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2359
Dated: March 10, 2004